

### **III. REMARKS/ARGUMENTS**

#### **A. Status of the Application**

Claims 1-6, 8-22, 24-28, and 30-37 are pending. Claims 1 and 22 have been amended. Reconsideration of claims 1-6, 8-22, 24-28, and 30-37 is respectfully requested.

#### **B. Rejections under 35 U.S.C. § 102(b)**

Claims 1-6, 8, 9, 12-15 and 20 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 6,013,323 to Klayder et al. ("Klayder '323"). Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

Claim 1, as amended, is drawn to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Claims 2-6, 8, 9, 12-15 and 20 depend, directly or indirectly, from and include all of the subject matter of claim 1.

As provided in MPEP §2131, "[t]o anticipate a claim, the reference must teach every element of the claim...". Therefore, Klayder '323 must disclose all of the elements of independent claim 1 and dependent claims 2-6, 8, 9, 12-15 and 20 to sustain the rejection under 35 U.S.C. §102(b). Klayder '323, however, does not meet the standard required by MPEP §2131 because Klayder '323 does not disclose each and every element of independent claim 1.

Specifically, Klayder '323 relates to aqueous based, gelled silicone compositions, particularly waxes and protectants, which are substantially free of volatile organic solvents. In the Office action dated September 28, 2004, the Examiner directed particular attention to Example 2 of Klayder '323 and noted that the composition disclosed therein includes a silicone microemulsion and Silwet® 7606, a polyalkylene oxide modified silicone surfactant. In fact, as disclosed at col. 5, lines 8-11 of Klayder '323, Silwet® 7606 is a polyalkyl alkaline oxide modified polydimethylsiloxane silicone surfactant.

In contrast, claim 1 is directed to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

As acknowledged by the Examiner in the Office action dated March 1, 2005, Klayder '323 does not disclose a composition that includes a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Accordingly, Klayder '323 does not disclose each and every element of independent claim 1.

Thus, as Klayder '323 does not disclose each and every element of claim 1, Applicants submit that the rejection of claim 1 under 35 U.S.C. §102(b) over Klayder '323 should be withdrawn.

As noted above, claims 2-6, 8, 9, 12-15, and 20 each depend, directly or indirectly, from and include the subject matter of claim 1. Therefore, the rejection of claims 2-6, 8, 9, 12-15 and 20 under 35 U.S.C. §102(b) over Klayder '323 should be withdrawn for at least the same reasons as noted above with respect to claim 1.

In view of the foregoing, Applicants request that the rejection of claims 1-6, 8, 9, 12-15, and 20 under 35 U.S.C. §102(b) over Klayder '323 be withdrawn.

Claims 1, 3-6, 8-10, 12, 14, 15, 18, 19, 22, 25-28, 30-34, 36 and 37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,661,208 to Estes ("Estes '208"). Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

As noted above, claim 1, as amended, is directed to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Claims 3-6, 8-10, 12, 14, 15, 18 and 19 depend, directly or indirectly, from and include all of the subject matter of claim 1.

Claim 22, as amended, is drawn to a method of forming a durable, shiny, water repellent coating on a tire by applying to the surface of a tire a tire-dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Claims 25-28, 30-34, 36 and 37 depend, directly or indirectly, from and include all of the subject matter of claim 22.

As provided in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim...". Therefore, Estes '208 must disclose all of the elements of independent claims 1 and 22 as well as dependent claims 3-6, 8-10, 12, 14, 15, 18, 19, 25-28, 30-34, 36 and 37 to sustain the rejection under 35 U.S.C. §102(b). Estes '208, however, does not meet the standard required by MPEP §2131 because Estes '208 does not disclose each and every element of independent claims 1 and 22.

Specifically, Estes '208 relates to a rubber or vinyl surface protectant that includes a silicone component and an acrylic component. As disclosed at col. 1, lines 62-65 of Estes '208, the silicone component of the protectant composition is an aqueous emulsion or microemulsion

of a polydimethylsiloxane that is stabilized by one or more ionic or nonionic surfactants. In the Office action dated September 28, 2004, the Examiner directed particular attention to col. 2, lines 33-35 of Estes '208 and noted that the silicone component can be a silicone glycol copolymer.

In contrast, claim 1 is directed to a tire dressing composition and claim 22 is directed to a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

Estes '208 does not disclose a composition or a method of forming a coating by applying to the surface of a tire a tire dressing composition that includes a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Accordingly, Estes '208 does not disclose each and every element of independent claims 1 and 22.

Thus, as Estes '208 does not disclose each and every element of claims 1 and 22, Applicants submit that the rejection of claims 1 and 22 under 35 U.S.C. § 102(b) over Estes '208 should be withdrawn.

As noted above, claims 3-6, 8-10, 12, 14, 15, 18, 19, 25-28, 30-34, 36 and 37 each depend, directly or indirectly, from and include the subject matter of claim 1 or claim 22. Therefore, the rejection of claims 3-6, 8-10, 12, 14, 15, 18, 19, 25-28, 30-34, 36 and 37 under 35 U.S.C. § 102(b) over Estes '208 should be withdrawn for at least the same reasons as noted above with respect to claims 1 and 22.

In view of the foregoing, Applicants request that the rejection of claims 1, 3-6, 8-10, 12, 14, 15, 18, 19, 22, 25-28, 30-34, 36 and 37 under 35 U.S.C. §102(b) over Estes '208 be withdrawn.

### C. Rejections under 35 U.S.C. §103(a)

Claims 16, 17, 21, 22, 24-28, 30, 31, and 35-37 stand rejected under 35 U.S.C. § 103(a) over Klayder '323. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the *prima facie* case fails.

Applying the criteria set forth in MPEP § 2142, it is clear, as noted above, that Klayder '323 does not teach or disclose all of the limitations of claims 1 and 22 or claims 16, 17, 21, 24-28, 30, 31, and 35-37 which depend, directly or indirectly, from and include the subject matter of claim 1 or claim 22. Specifically, Klayder '323 does not disclose or suggest a tire dressing composition or a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition, in which the tire dressing composition includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

In addition, there is no suggestion or motivation to modify Klayder '323 to include all of the limitations of claims 1 and 22 as noted above. Without a proper suggestion or motivation for modification of Klayder '323 to include a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent in the tire dressing composition, there could be no reasonable expectation of success.

Accordingly, Applicants submit that a *prima facie* case of obviousness over Klayder '323 has not been made with respect to claims 1 and 22 because none of the three criteria of the *prima facie* case has been satisfied. Applicants further submit that the *prima facie* case also fails with respect to claims 16, 17, 21, 24-28, 30, 31, and 35-37, each of which depends, directly or indirectly, from claims 1 or 22 for at least the same reasons as noted above with respect to claims 1 and 22.

In view of the foregoing, Applicants request that the rejection of claims 16, 17, 21, 22, 24-28, 30, 31, and 35-37 under 35 U.S.C. § 103(a) over Klayder '323 be withdrawn.

Claims 1-6, 8-11, and 14-21 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,244,598 to Merrifield et al. ("Merrifield '598"). Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the *prima facie* case fails.

Merrifield '598 relates to a method of preparing an amino-functional polyorganosiloxane microemulsion in which an oil mixture is formed by blending an amino-functional polyorganosiloxane and a surfactant that is insoluble in the amino-functional polyorganosiloxane. In the Office action dated September 28, 2004, the Examiner directed particular attention to col. 4, lines 35-38 of Merrifield '598 and noted that the surfactants may include alkoxylated siloxane surfactants containing ethylene oxide and/or propylene oxide groups.

In contrast, and, as noted above, claim 1 is directed to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

Applying the criteria set forth in MPEP § 2142, it is clear that Merrifield '598 does not teach or disclose all of the limitations of claim 1 or claims 2-6, 8-11, and 14-21 which depend, directly or indirectly, from and include the subject matter of claim 1. Specifically, Merrifield '598 does not disclose or suggest a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

In addition, there is no suggestion or motivation to modify Merrifield '598 to include all of the limitations of claim 1 as noted above. Without a proper suggestion or motivation for modification of Merrifield '598 to include a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent in the tire dressing composition, there could be no reasonable expectation of success.

Accordingly, Applicants submit that a *prima facie* case of obviousness over Merrifield '598 has not been made with respect to claim 1 because none of the three criteria of the *prima facie* case has been satisfied. Applicants further submit that the *prima facie* case also fails with respect to claims 2-6, 8-11, and 14-21, each of which depends, directly or indirectly, from claim 1 for at least the same reasons as noted above with respect to claim 1.

In view of the foregoing, Applicants request that the rejection of claims 1-6, 8-11, and 14-21 under 35 U.S.C. § 103(a) over Merrifield '598 be withdrawn.

Claims 11, 16, 17, 21, and 33 stand rejected under 35 U.S.C. § 103(a) over Estes '208. Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the *prima facie* case fails.

As noted above, claim 1, as amended, is directed to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Also as noted above, claim 22, as amended, is drawn to a method of forming a durable, shiny, water repellent coating on a tire by applying to the surface of a tire a tire-dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Claims 11, 16, 17, 21 and 33 depend, directly or indirectly, from and include the subject matter of claims 1 or 22.

Applying the criteria set forth in MPEP § 2142, it is clear, as noted above, that Estes '208 does not teach or disclose all of the limitations of claims 1 and 22 or claims 11, 16, 17, 21, and 33 which depend therefrom. Specifically, Estes '208 does not disclose or suggest a tire dressing composition or a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition, in which the tire dressing composition includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

In addition, there is no suggestion or motivation to modify Estes '208 to include all of the limitations of claims 1 and 22 as noted above. Without a proper suggestion or motivation for modification of Estes '208 to include a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent in the tire dressing composition, there could be no reasonable expectation of success.

Accordingly, Applicants submit that a *prima facie* case of obviousness over Estes '208 has not been made with respect to claims 1 and 22 because none of the three criteria of the *prima facie* case has been satisfied. Applicants further submit that the *prima facie* case also fails with

respect to claims 11, 16, 17, 21 and 33, each of which depends, directly or indirectly, from claims 1 or 22 for at least the same reasons as noted above with respect to claims 1 and 22.

In view of the foregoing, Applicants request that the rejection of claims 11, 16, 17, 21 and 33 under 35 U.S.C. § 103(a) over Estes '208 be withdrawn.

Claims 13 and 35 stand rejected under 35 U.S.C. § 103(a) over Estes '208 in view of U.S. Patent No. 6,080,387 to Zhou et al. ("Zhou '387"). Insofar as it may be applied to the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP § 2142 at 2100-124. If even one of these criteria is not met, then the prima facie case fails.

As noted above, claim 1, as amended, is directed to a tire dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Also as noted above, claim 22, as amended, is drawn to a method of forming a durable, shiny, water repellent coating on a tire by applying to the surface of a tire a tire-dressing composition that includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Claims 13 and 35 depend, directly or indirectly, from and include all of the subject matter of claim 1 and 22, respectively.

Applying the criteria set forth in MPEP § 2142, it is clear, as noted above, that Estes '208 does not teach or disclose all of the limitations of claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively. Specifically, Estes '208 does not disclose or suggest a tire dressing composition or a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition which includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent.

In addition, Zhou '387 does not teach or disclose all of the limitations of claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively. Specifically, and as noted in the Office action dated September 28, 2004, Zhou '387 was cited for the disclosure of a corrosion

inhibitor. Zhou '387, however, does not supply the above-noted deficiencies of Estes '208 with respect to claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively.

Accordingly, the third criterion of a *prima facie* case of obviousness has not been met because Estes '208 and Zhou '387 alone or in combination do not teach or disclose all of the limitations of claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively.

Moreover, there could be no reasonable expectation of success, nor could there be a suggestion or motivation, to modify the compositions and methods disclosed in Estes '208 and Zhou '387, or to combine the references, to achieve the subject matter of claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively. As noted above, neither Estes '208 nor Zhou '387 provide any teaching, disclosure, suggestion or motivation of a tire dressing composition or a method of forming a coating on a tire by applying to the surface thereof a tire dressing composition, in which the tire dressing composition includes a silicone microemulsion and a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent. Thus, there can be no suggestion or expectation of success for such a modification of either reference. Furthermore, there can be no suggestion or expectation of success to combine the two references. In fact, even if the references could be properly combined, the resulting compositions would not achieve the subject matter of claims 1 and 22 or claims 13 and 35 which depend therefrom, respectively. Thus, the first and second criteria needed to establish a *prima facie* case of obviousness have also not been met.

Accordingly, there is no suggestion or motivation to combine or modify Estes '208 or Zhou '387 to accomplish the subject matter of claims 1 and 22 or claims 13 and 35, and, even further, there is clearly no suggestion or motivation to modify Estes '208 or Zhou '387 to provide the elements of claims 1 and 22 or claims 13 and 35 noted above as lacking in their disclosures. The Office Action does not recite any particular evidence that would provide the teaching or suggestion that is lacking in the references. In this regard, MPEP § 2143.01 provides that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP§ 2143.01 at 2100-126.

In the absence of a teaching or suggestion of combination in the references themselves, as well as the absence of other particular evidence teaching or suggesting the combination,

Applicants can only conclude that the suggestion or motivation for the combination of Estes '208 or Zhou '387 applied in the Office Action arises solely from impermissible hindsight.

Even if there were a suggestion or motivation to combine the references, the combination would not result in or be the equivalent of claims 1 and 22 or claims 13 and 35 because neither reference discloses or suggests all of the elements of claims 1 and 22 or claims 13 and 35. Accordingly, there could be no reasonable expectation of success for a combination of Estes '208 and Zhou '387.

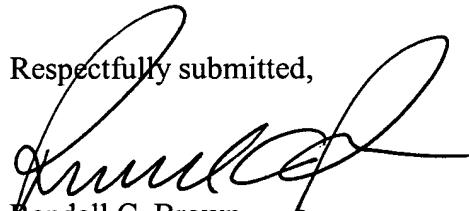
In view of the foregoing, Applicant submits that a prima facie case of obviousness over Estes '208 in view of Zhou '387 has not been made with respect to claims 13 and 35 and requests that the rejection of claims 13 and 35 over Estes '208 in view of Zhou '387 be withdrawn.

**D. Conclusion**

Claims 1-6, 8-22, 24-28, and 30-37 are now pending in the present application. In view of the foregoing, allowance of all pending claims is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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